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SEP 28 2006

**PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Atty Docket No.: A01477
CPH/d

In re Application of:

Ronald Scott Beckley

:

Serial No.: 10/660,186

:

Group Art Unit: 1713

Filed: September 11, 2003

:

Examiner: Michael Bernshteyn

For: MICHAEL ADDITION COMPOSITIONS

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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**Notice of Appeal
Request for Review Prior to Appeal Brief
Reasons for Request for Review**

9-28-06
Date

Lisa Dawson
Signature

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Doc Code: AP.PRE.REQ

SEP 28 2006

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

A01477

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Application Number

10/660,186

Filed

9/11/2003

First Named Inventor

Ronald Scott Beckley

Art Unit

1713

Examiner

M. Bernshteyn

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number *51,798*

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Telephone number

September 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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Docket No.: : A01477

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/660,186
Applicant : Ronald Scott Beckley
Filed : 9/11/2003
Title : Michael Addition Compositions

TC/Art Unit : 1713
Examiner : Michael Bernshteyn

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-6 and 11-20 are pending in this application. The claims as currently pending were presented in Applicant's paper of August 28, 2006.

Response to rejection of claims 1-6 and 11-20 over Irie

In the Office Action mailed on 06/29/2006, the Examiner rejected claims 1-6 and 11-20 under 35 USC §102(b) as being anticipated by US 5,959,028 (Irie). In the Advisory Action mailed on 9/1/2006, the Examiner maintained the rejection.

Applicants respectfully traverse the rejection. Applicants submit that Irie fails to teach or suggest the limitation of the present claims regarding non-reactive volatile compounds. Thus, a limitation is not met by the reference, and Applicants request that a panel reviews the rejection prior to the filing of an appeal brief.

Irie teaches an invention that "provides a curable resin composition" that comprises three ingredients, labeled "(a)" and "(b)" and "(c)" (col. 2, lines 7-14). Irie defines these ingredients as follows:

"(a) a component containing a plurality of alpha, beta-ethylenically unsaturated carbonyl groups in the molecule;

(b) an acrylate polymer containing a plurality of malonate-terminated pendant groups in the molecule; and

(c) a catalyst capable of promoting the Michael reaction." (col. 2, lines 7-14).

Irie further teaches, under the heading "Curable resin compositions" (col. 6, line 10) as follows:

"All of components (a), (b), and (c) are dissolved or dispersed in an organic solvent conventionally used in the coating industry." (col 6, lines 19-21)

The term "solvent" is well known in the coatings industry to mean a substance that is volatile and is non-reactive with the components of the coating. The examples of solvents given by Irie (col. 6, lines 21-32) are well known as volatile, non-reactive substances. Thus, Irie teaches compositions in which (a), (b), and (c) are dissolved or dispersed in a volatile, non-reactive substance.

Additionally, it is well known that, in order for a composition to have ingredients that are "dissolved or dispersed" in a solvent, as in Irie's invention, the amount of solvent in the composition must be much more than 5% by weight of the composition. Irie's Examples illustrate this generalization. For instance, in Production Example 1, Irie discloses making an example of ingredient (b) as a solution of 49.4% nonvolatiles (col. 6, line 57) (i.e., with 50.6% volatile compounds). Irie proceeds to disclose a "curable resin composition" in Example 1, as follows:

<u>Ingredient</u>	<u>solid parts</u>	<u>volatile parts</u>
Production Example 1 (b)	200	205
PETA (a)	50	
TBABr (c)	2	
TINUBIN	10	
SANOL LS-400	5	

Thus, Irie's Example 1 has 205 parts volatiles out of a total of 472 parts, for a volatile amount of 43%. Irie teaches that Examples 2-30 follow Example 1 (col. 8, line 48). Thus, Irie is teaching that Examples 2-30 have volatile amounts of approximately 43%.

Irie also discloses Example 31. In Example 31, Irie discloses that a steel plate is first coated with three coatings, none of which are disclosed to contain any of Irie's (a), (b), or (c) (col. 12, lines 41-64). Irie then states:

"Then, the solution of Example 1 adjusted to Ford cup #4 viscosity of 30 seconds was applied electrostatically onto the base coat wet-on-wet, and baked both films simultaneously at 140°C for 25 minutes." (col. 12, line 66 to col. 13, line 2).

It is well known in the coatings art that the viscosity of a composition is "adjusted" by adding more solvent to reduce the viscosity of the composition. Thus, the solution of Irie's curable resin composition that is disclosed to be used in Example 31 has even higher proportion of non-reactive volatile compounds than the solution disclosed in Example 1.

To summarize Irie's teachings: Irie discloses that his ingredients (a), (b), and (c) are dissolved or dispersed in solvent, and all of Irie's Examples disclose solutions of (a), (b), and (c) that have amount of solvent that is approximately 43% or higher. Thus, Irie teaches compositions that contain much higher quantities than 5% of volatile, non-reactive compounds. Irie does not teach or suggest the use of compositions with 5% or less of non-reactive volatile compounds.

(Applicants note that in a paper submitted on August 28, 2006, Applicants characterized Irie's Example 31 as disclosing compositions with "at least 10%" solvent. Applicants submit that the figure of "at least 10%" was based on an analysis of the "base coating" in Irie's Example 31, which does not contain any of Irie's (a), (b), or (c). Thus, Applicants submit that the characterization of Irie's Example 31 presented herein above is correct and accurate).

In contrast to Irie's disclosed compositions, the compositions recited in the present claims contain 5% or less of non-reactive volatile compounds. Present claim 1 states:

"1. A curable mixture comprising at least one multi-functional Michael donor, at least one multi-functional Michael acceptor, and at least one anion of a Michael donor, wherein said curable mixture comprises 5% or less by weight non-reactive volatile compounds, based on the total weight of said curable mixture, wherein each Michael acceptor functional group in said multifunctional Michael acceptor is a residue of acrylic acid, methacrylic acid, fumaric acid, or maleic acid."

Applicant submits that the language of present claim 1 clearly places a maximum of 5% on the amount of non-reactive volatile compounds. The transition term "comprising" at the beginning of present claim 1 allows the inclusion of materials other than those already recited in the claim (such as, for example, the non-volatile adjuvants described in the present specification on p. 13, lines 19-25). However, present claim 1 does not allow inclusion of more than 5% non-reactive volatile compounds.


In sum, the compositions taught by Irie have relatively large amounts of non-reactive volatile compound (i.e., solvent), typically approximately 43%. In contrast, the compositions of present claim 1 require 5% or less of non-reactive volatile compounds. All of the remaining present claims are dependent, directly or indirectly, on present claim 1. Consequently, Applicants submit that Irie fails to teach or suggest the compositions of the present claims. Therefore, Applicants submit that the present claims are novel over Irie. Applicants request that a panel review the rejection and allow the present claims.

Appl. No. 10/660,186
Paper dated September 28, 2006
Reasons for Pre-Appeal Brief Request for Review

Docket No. A01477

Respectfully Submitted,

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